



# UNITED STATES PATENT AND TRADEMARK OFFICE

ck

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/812,469	03/29/2004	Anja Bauer	P30829	3148
7055 7590 09/17/2007 GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191			EXAMINER JEAN-LOUIS, SAMIRA JM	
			ART UNIT 1609	PAPER NUMBER
			NOTIFICATION DATE 09/17/2007	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

gbpatent@gbpatent.com  
pto@gbpatent.com

## Office Action Summary

**Application No.**

10/812,469

**Applicant(s)**

BAUER ET AL.

**Examiner**

Samira Jean-Louis

**Art Unit**

1609

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 9, 10, 16 and 17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 11-14 is/are rejected.
- 7) ☒ Claim(s) 15 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date Sheets (1)
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Information Disclosure Statement***

The inclusion of a copy of an International Search Report in the IDS has not been considered because they are non-published documents and cannot be properly cited on a 1449 due to lack of a date of publication.

### ***Priority***

Acknowledgment is made of applicant's claim for foreign priority. It is noted, however, that applicant has not provided English translations of the German applications as required by 35 U.S.C. 119(b). Thus, the priority date of the instant invention is September 27, 2002 (the date of the PCT application). Without the English translations, one cannot ascertain if the instant invention is present in the German applications. Therefore, art prior to the PCT date, but not before the date of the German applications has been cited against the claims.

### ***Election/Restrictions***

Claims 1-17 are pending in the application; however, claims 1-8, 11-15 are being examined on the merits herein.

Art Unit: 1609

Applicant's election with traverse to various species in the reply filed on 08/29/07 is acknowledged. The traversal is on the ground(s) that the search of all the groups and species does not impose an undue burden upon the examiner. This is not found persuasive because the claims recited in the instant application recite a multiplicity of species of stabilizers and water-in-oil emulsifiers that possess different chemical properties and are different in chemical structure and would therefore acquire separate status in the art (i.e. different classification). While applicant's assertion about the fact that a search for the composition might overlap that of the method, examiner respectfully disagrees about the lack of burden given that a search for the method of using said composition would consist of searching multiple databases for various references and literature searches that are contrastingly different to the search for the composition itself. Consequently, the search would be unduly extensive and burdensome.

Thus, the requirement is still deemed proper and is therefore made FINAL.

Claims 9-10, and claims 16-17 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected group and species, there being no allowable generic or linking claim.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-7, and 11-12 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Schreiber et al. (U.S. 6, 613, 338 B1) in view of Fujiyama et al. (U.S. 3, 957, 969).**

Schreiber et al. teaches a water-in-oil emulsion comprising a lipid phase made up of an oil component and a wax component, a 30-85% aqueous phase, a water-in-oil emulsifier, a stabilizer, an active ingredient, and additional substances, if desired (see abstract, instant claim 1). Specifically, this composition entails a water-in-oil emulsion cosmetic stick (see column 1, lines 1-8), which contains 2% glycerol, the skin-moisturizing agent (see examples 1-27, columns 15-23) (instant claim 11)). Moreover, the work of Schreiber et al. reads upon the majority of the embodiments of claim 2 and the specific embodiments of claim 3 (see columns 4-6 vs. instant claims 2-3). The work of Schreiber et al. also disclosed the use of polyglyceryl-3-diisostearate, a water-in-oil emulsifier, and the use of a stabilizer in the aforementioned water-in-oil emulsion (see column 5, lines 21-26 vs. instant claim 4; column 6, lines 39-67 and column 7, lines 1-45

vs. instant claims 5-6). Furthermore, the composition of Schreiber et al. may further entail pigments and filters comparable to that disclosed by applicant (see column 10, lines 55-60 vs. instant claim 7).

Schreiber et al. does not specifically teach a composition with 5-50% of glycerol that is spreadable and storage-stable in a temperature range from  $-10^{\circ}\text{C}$  to  $50^{\circ}\text{C}$ .

Fujiyama et al. teaches that a cosmetic stick comprising water-in-oil emulsion can contain glycerol in the range of 1-10% by weight (see column 1, lines 40-42). Moreover, Fujiyama et al. conducted experiments to test the storage stability of the water-in-oil emulsion cosmetic stick at  $0^{\circ}\text{C}$ - $38^{\circ}\text{C}$  and observed no change (see column 4, lines 43-48 vs. instant claim 12). Likewise, the spreadability of the aforementioned composition was tested and was found to have excellent spreading property (see column 5 line 34). While no temperature range was given by Fujiyama for the spreadability property, Fujiyama is considered to teach spreadability at  $33^{\circ}\text{C}$  given that he discloses that the composition is able to spread readily on human skin (see column 3, line 54).

Thus, to one of ordinary skill in the art at the time of the invention would have found it obvious to combine the composition of Schreiber et al. with that of Fujiyama to arrive at the composition of applicant since Schreiber et al. in view of Fujiyama essentially teaches a composition of cosmetic stick of water-in-oil emulsion containing a lipid phase with oil and wax, a 30-85% aqueous phase, 1-10% glycerol,

Art Unit: 1609

and polyglyceryl-3-diisostearate. Given that Schreiber teaches a cosmetic stick of water-in-oil emulsion and Fujiyama discloses that 1-10% glycerol can be added to such composition and that such a composition can be spreadable and storage-stable within the range of 0°C-38°C, one of ordinary skill would have been motivated to combine the composition of Schreiber et al. with the composition of Fujiyama with the expectation of providing a water-in-oil emulsion stick that is moisturizing, spreadable, and storage-stable comparable to applicant's invention.

**Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schreiber et al. (U.S. 6, 613, 338 B1) in view of Fujiyama et al. (U.S. 3, 957, 969) as applicable to claims 1-7, and 11-12 above and in further view of Butuc (U.S. 2002/0055562 A1).**

The Schreiber and Fujiyama references are as discussed above. However, Schreiber and Fujiyama do not address the addition of an anti-wrinkle substance in the water-in-oil emulsion stick.

Butuc teaches a two-phase gel stick (see page 21, paragraph 122) containing ubiquinone (see page 11, paragraph 50) and anti-wrinkle agents (see page 20, paragraph 118) (instant claim 8)). Butuc has been provided to demonstrate that ubiquinone and anti-wrinkle agents can be added to cosmetic stick in order to beautify and alter appearances.

Thus, to one of ordinary skill in the art at the time of the invention would have found it obvious to add ubiquinone and anti-wrinkle agents in view of the knowledge of provided by Butuc to the combined composition of Schreider and Fujiyama to arrive at the composition of applicant. Given that Schreiber teaches a water-in-oil emulsion stick, and Fujiyama discloses that glycerol can be added for better moisturizing, spreadable and storage-stable properties, and Butuc discloses that ubiquinone and anti-wrinkling agents can also be added to cosmetic sticks, one of ordinary skill would have been motivated to add ubiquinone and anti-wrinkling agents to the composition of Schreiber et al. with the disclosures of Fujiyama and Butuc with the expectation of providing a water-in-oil emulsion stick that is moisturizing, spreadable and storage-stable.

**Claims 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schreiber et al. (U.S. 6, 613, 338 B1) in view of Fujiyama et al. (U.S. 3, 957, 969) as applicable to claims 1-7, and 11-12 above and in further view of Fabrisi (U.S. 5, 860, 756).**

The Schreiber and Fujiyama references are as discussed above. However, Schreiber and Fujiyama do not address the water-in-oil emulsion stick in a sleeve-like packaging filled on both sides.

Fabrisi teaches a top-fill/bottom-fill cosmetic carrier for a lipstick container that can be filled either from the top or the bottom (see abstract-instant claim 14).



Art Unit: 1609

Specifically, Fabrisi teaches that such carrier has utility for various cosmetics and that this carrier is positioned within a tubular inner sleeve (see column 4, lines 8-40).

Thus, to one of ordinary skill in the art at the time of the invention would have found it obvious to combine the composition of Schreiber et al. in view of Fujiyama with the carrier of Fabrisi to arrive at the composition of applicant in a sleeve like packaging for better versatility and ease of application. Given that Schreiber teaches a water-in-oil emulsion stick and Fabrisi teaches a tubular sleeve carrier for such composition that is top or bottom filled, one of ordinary skill would have been motivated to combine the composition Schreiber with the carrier of Fabrisi in view of Fujiyama with the expectation of providing a water-in-oil emulsion stick that is versatile and easily applicable as is the composition disclosed in applicant's invention.

### ***Objection***

Claim 15 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Conclusion***

Claims are rejected. No claims are allowed.

Art Unit: 1609


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samira Jean-Louis whose telephone number is 571-270-3503. The examiner can normally be reached on 7:30-5 PM EST M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin H. Marschel can be reached on 571-272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SJL

09/05/2007

  
ARDIN H. MARSCHEL  
SUPERVISORY PATENT EXAMINER